

Please amend the claims as follows:

1 1. (original) A method of providing continuing medical education credit to a first physician  
2 who has been engaged in a consultation with a second physician via an intermediary, the  
3 intermediary being connected by a telecommunications system to both the first and  
4 second physicians,  
5 the method comprising the steps performed in the intermediary of:  
6 receiving a comment made with regard to the consultation via the telecommunications  
7 system from the second physician; and  
8 providing the comment to a medical information specialist in the intermediary who is  
9 neither the first nor the second physician, the medical information specialist indicating  
10 continuing medical education credit for the first physician based at least on the comment in a  
11 database accessible from the intermediary.

1 2. (currently amended) The method of providing continuing medical education credit set forth in  
2 claim 1 wherein the method further comprises the steps of:  
3 retrieving instructional material relevant to the comment and the consultation from the  
4 ~~information-data base and~~  
5 providing the instructional material to the first physician via the telecommunications  
6 system,  
7 the step of retrieving instructional material being performed by the medical information  
8 ~~expert~~specialist.

1 3. (original) The method of providing continuing medical education credit set forth in claim 2  
2 wherein the method further comprises the steps of:

3 providing an examination based on at least the instructional material via the  
4 telecommunications system;

5 receiving answers for the examination from the first physician via the  
6 telecommunications system;

7 grading the received answers; and

8 if the first physician passes the examination, providing the continuing medical education  
9 credit.

1 4. (original) The method of providing continuing medical education credit set forth in claim  
2 1 wherein the method further comprises the steps of:

3 providing an examination based on at least the comment to the first physician via the  
4 telecommunications system;

5 receiving answers for the examination from the first physician via the  
6 telecommunications system;

7 grading the received answers; and

8 if the first physician passes the examination, providing the continuing medical  
9 education credit.

## Remarks

### The amendment of claim 2

The amendment only serves to make it clear that the “data base” of claim 2 is the “data base” of claim 1 and that the “medical information expert” of claim 2 is in fact the “medical information specialist” of claim 1. The claim as amended is thus fully supported by the Specification as filed. The amendment further has no effect whatever on the scope of claim 2.

### Traversal of the rejection under 35 U.S.C. 101

Examiner grounds her rejection of the claims under 35 U.S.C. 101 on a “two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.”

(Examiner’s Office action, ¶ 4)

Examiner cites no authority for the above “two-prong test”. She then goes on to state that

“Mere ideas in the abstract . . . that do not apply involve, use, or advance the technological arts fail to promote the ‘progress of science and the useful arts’ . . . and are therefore found to be non-statutory subject matter” and that “claims 1-4 only recite abstract ideas” because the steps recited in the claim “can be performed in the mind of the user or by use of a pencil and a paper” (Examiner’s Office action, ¶4)

Applicants’ claim 1 is the only independent claim. It reads as follows:

1. A method of providing continuing medical education credit to a first physician who has been engaged in a consultation with a second physician via an intermediary, the intermediary being connected by a telecommunications system to both the first and second physicians, the method comprising the steps performed in the intermediary of:  
     receiving a comment made with regard to the consultation via the telecommunications system from the second physician; and  
     providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist indicating continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary.

The above claim is not about “abstract ideas”. It is about “a method of providing continuing medical education credit to a first physician who has been engaged in a

consultation with a second physician via an intermediary, the intermediary being connected by a telecommunications system to both the first and second physicians. The method steps recite a flow of information (the comment) from the second physician to the intermediary via the telecommunications system and an action performed by a medical information specialist which involves the information and results in another item of information (the continuing medical education credit) being indicated to a "database accessible to the intermediary". The steps of the method thus do not recite an "abstract idea", and Examiner's rejection is therefore without basis by its own terms.

Examiner's rejection is further without basis because the discussion of patentable subject matter in MPEP 2106 (Rev. 2, May 2004) makes clear that Examiner's "two-prong test" is simply not relevant to the examination of patent applications. As set forth at MPEP 2106A, what determines whether an invention is directed to subject matter that "represents nothing more than an idea or concept" is the following:

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). (MPEP Rev. 2, May 2004, p. 2100-6, col. 1)

Examiner herself admits that the continuing medical education credit is "a useful, concrete, and tangible result", and beyond that, it is clear from both the claim and the Specification that the method of claim 1 indeed "accomplishes a practical application" and has "a certain level of 'real world value'", since it enables a physician who is consulting with another physician to obtain continuing medical education credit as well as medical advice by way of the consultation. Since the invention claimed in claim 1 in fact "accomplishes a practical application" and "produces a useful, concrete, and tangible result", claim 1 is addressed to patentable subject matter under 35 U.S.C. 101.

**Traversal of the rejection of claims 1 and 2 under 35 U.S.C. 102**

Examiner bases her rejection on 35 U.S.C. 102(e), but since the reference is not a patent or patent application and was published less than 1 year before the filing date of the parent of the present patent application, the rejection is more properly based on 35 U.S.C. 102(a). In the following, Applicants will show that the reference does not anticipate Applicants' claims 1 and 2. This showing is not, however, to be understood as an admission that the publication date of the reference predates Applicants' date of invention.

Telemedicine is a 1996 survey of the new possibilities that the improvements in information processing and telecommunications which were taking place in the 1990's offered the medical profession. Among the possibilities considered in the VVA report are "the transmission of health care information and information on education and administrative services" (p.1, col. 1, bottom) and the use of "two-way, interactive telecommunications video systems to examine patients from remote locations, to facilitate medical consultations, and to train health care professionals" (p.1, col. 2, bottom). Further discussed are the uses of the technology for rural hospitals and health providers (page 3, col. 1, top) and the University of Washington's use of telecommunications technology to overcome distance with regard to medical education, delivery of health care, and conferences among providers (page 4, col. 2, middle). There is also a discussion of the difference for licensing purposes between using telecommunications technology to provide care directly to a patient from an out of state location and using the technology for consultations between doctors. (page 14, col. 2, top) Implications for medical practice of live and store-and-forward telecommunications interactions are discussed at page 19, col. 1, beginning in the second paragraph.

The problem with all of this disclosure is that, as might be expected from the nature of Telemedicine, there is no detailed disclosure of particular uses of telecommunications in medicine. A rejection of a claim under 35 U.S.C. 102, however, requires that the reference that is serving as the basis of the rejection disclose every limitation of the claim being rejected. Telemedicine provides no such disclosure with regard to the method of Applicants' claim 1. As set forth in the claim's preamble, Applicants' claim 1 is directed to "a method of providing continuing medical education credit". As further set forth in the

preamble, the “continuing medical education credit” is provided under very particular circumstances: it is provided “to a first physician who has been engaged in consultation with a second physician via an intermediary”. Finally, the steps are “performed in the intermediary”.

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The environment set up by the preamble is referred to repeatedly in the steps of the method, and thus must be taken into account in interpreting the claim. Thus, the “comment” of the first method step is “made with regard to the consultation” and “received via the telecommunications system from the second physician”. Further, in the second step, the  
 10 comment is provided “to a medical information specialist in the intermediary” and the medical information specialist “indicat[es] continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary”.

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In her rejection, Examiner refers Applicants to many locations in Telemedicine, but none of these locations describe or suggest *any* “method for providing a continuing education credit”, let alone one that involves a first physician, a second physician, an intermediary that is connected to the physicians by a telecommunications system and that has a medical information specialist who uses a comment received from the consulting physician via the telecommunications system and uses it as a basis for providing a continuing education  
 20 credit in a “database accessible from the intermediary”. Since Telemedicine discloses none of these limitations of claim 1, it does not anticipate the claim and the rejection of the claim under 35 U.S.C. 102 is without basis.

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The rejections of claim 2-4 depend on the disclosure by Telemedicine of all of the limitations of claim 1. Since Telemedicine does not disclose all of these limitations, it also cannot disclose all of the limitations of claim 2 or be combined with the Abrahamson reference to disclose all of the limitations of claims 3 and 4. Consequently, all of the claims are patentable over the references.

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*Patentability of the dependent claims in their own rights*

Continuing with claim 2, Telemedicine discloses nothing about the use of an intermediary in a consultation between doctors, and can thus disclose nothing about the additional steps

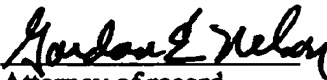
performed in the intermediary in the claim. Claim 2 is thus patentable in its own right over Telemedicine.

With regard to claims 3 and 4, Examiner finds the added limitations in Abrahamson. Applicants respectfully submit that Abrahamson teaches nothing beyond the use of a computer system to give and grade examinations. The added limitations of claims 3 and 4, however, are added to the contexts provided by claims 2 and 1 respectively, and Abrahamson discloses nothing regarding these contexts, and therefore cannot disclose the added limitations. These claims are consequently patentable in their own rights over Telemedicine and Abrahamson.

### Conclusion

Applicants have amended claim 2 to overcome antecedent problems discovered by Applicants and have shown that the amended claim is fully supported by the Specification as filed. Applicants have further traversed the rejection of claims 1-4 under 35 U.S.C. 101, the rejection of claims 1-2 under 35 U.S.C. 102(a), and the rejection of claims 3-4 under 35 U.S.C. 103. Applicants have thereby satisfied the requirements of 37 C.F.R. 1.111(b) and request that Examiner reconsider her rejections as provided by 37 C.F.R. 1.111(a). No fees are believed to be required by way of this amendment. Should any be, please charge them to deposit account 501315.

Respectfully submitted,

  
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